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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/712,984

11/12/2003

Gene Kirila II

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06/15/2005

BENESCH, FRIEDLANDER, COPLAN & ARONOFF LLP

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EXAMINER

YAN, REN LUO

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/712,984 | Applicant(s) KIRILA, GENE | |
| | Examiner Ren L. Yan | Art Unit 2854 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim 6 is missing. Accordingly, claims 7-18 have been renumbered as claims 6-17.

Applicant is advised to refer to the renumbered claims only in future communications with the Office.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 7-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Fujii et al(6,715,423). The patent to Fujii et al teaches the method of producing wallpaper in a retail location as claimed including displaying a plurality of wallpaper designs on a computer monitor that is in electrical communication with a computer-readable database DB containing stored digital images of the wallpaper designs, receiving an order for a selected wallpaper design from the consumer through the use of a computer, and printing the selected wallpaper design onto a suitable wallpaper substrate to produce the wallpaper or printing a sample of a selected wallpaper design for consumer use using a printer 32 located at the retail store. See Figs. 1-17, column 7, lines 44-53 and column 8, lines 17-29 in Fujii et al for details. Regarding claim 4, Figs. 6, 7 and 9 of Fujii et al teach the step of calculating an amount of wallpaper required by the consumer based on room dimensions supplied by the consumer. With respect to claims 10-12, Fujii et al

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also teach in column 7, lines 16-43 that a consumer can view the wallpaper designs on consumer's owner computer monitor and access the computer-readable database DB containing the stored digital images of the design via internet. Regarding claim 13, Fujii et al teach in column 1, lines 45-53 that the use of an inkjet printer to print wallpaper is well known and practiced in the art. With respect to claims 15-17, the claimed computer-readable medium or system are all met by the computer and printer equipment provided at the retail store 30 as taught by Fujii et al in column 7, lines 44-53.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

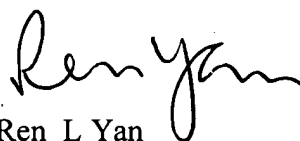
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al in view of Krinsky((6,631,683). The patent to Fujii et al teaches all that is claimed except for applying a protective layer to the substrate after the selected wallpaper design is printed and using a book to display wallpaper designs. The patent to Krinsky teaches to print wallpaper designs on books for display purposes and also suggests to provide a protective coating over the printed design on the printed wallpaper. See column 4, lines 3-43 in Krinsky for example. In view of the teaching of Krinsky, it would have been obvious to one of ordinary skill in the art to provide the printed wallpaper of Fujii et al with a protective coating so as to protect the printed image on the wallpaper and also to display the wallpaper designs in a book to facilitate the consumer's viewing of the wallpaper designs by just flipping through the pages.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L. Yan whose telephone number is 571-272-2173. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ren L Yan
Primary Examiner
Art Unit 2854

Ren Yan
June 7, 2005